



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,968	12/09/2003	John Kantor	P1229 US	6422
28390	7590	09/19/2005	EXAMINER	
MEDTRONIC VASCULAR, INC. IP LEGAL DEPARTMENT 3576 UNOCAL PLACE SANTA ROSA, CA 95403			SNOW, BRUCE EDWARD	
			ART UNIT	PAPER NUMBER
			3738	

DATE MAILED: 09/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/731,968	KANTOR, JOHN	
	Examiner	Art Unit	
	Bruce E. Snow	3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 29 August 2005.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-24 and 26-31 is/are pending in the application.
 4a) Of the above claim(s) 6,8 and 18 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-5,7,9-17,19-23 and 26-31 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Response to Arguments***

Applicant's arguments filed August 08, 2005, have been fully considered.

The amendments to all independent claims overcame the rejection under 35 U.S.C. 112, first paragraph wherein the language, "such that the lateral and longitudinal stability is improved" was new matter.

Regarding the rejection in view of Pinchuk et al applicant continues to argue that the stent cannot be defined as having first and second modules which, again, is not persuasive. Applicant states that in the stent art, the term modular stent has been used to define a stent in which discrete pieces are combined together; the Examiner believes applicant's argued definition is too narrow for one skilled in the stent art and not commensurate with the scope of the claim language and the specification. It is noted that paragraphs 0029 and 0030 do not support the language "individual" or "discrete". Applicant should consider amending the claims to reflect their argued definition.

Applicant has amended the claims requiring a polymer bridge coupling a first and second module such that the "lateral and longitudinal flexibility is improved"; this is a relative statement. It is the Examiner position that coupling the modules together compared with them being uncoupled decrease the relative movement and the lateral and longitudinal flexibility. The Examiner believes that the polymer bridges of Pinchuk do improve the flexibility when compared to welding them together as is well known in the art, this must be applicant's position also; see Cottone, Jr. (5,824,043) teaching welding. Finally, the Examiner notes that the materials taught by Pinchuk et al for the

bridges are “flexible” materials and are the same materials taught by applicant; inherently, the materials must function the same.

Regarding claim 13, requiring at least “radio-opaque”, it is the Examiner position that a radioactive material could be seen by “x-ray or other forms of radiant energy”.

Regarding at least claim 15, “module is manufactured from a porous material” is interpreted as a product by process limitation wherein the final product (module) does not have to be porous. A porous material can be melted into the mold to form the module.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 13 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicant specification fails to support/teach radio-opaque or echogenic materials included in the polymer bridge and further fails to teach any examples of such materials which fails to enable making and/or using the invention.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction

of the following is required: Applicant specification fails to support/teach radio-opaque or echogenic materials included in the polymer bridge.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-5, 7, 9-17, 19-23, 26-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Pinchuk et al (5,968,091).

Referring to figure 7, Pinchuk et al teaches a modular stent comprising:

A first stent module (a first plurality of zig-zags 34 (forming an approximate turn)) defining a first passageway;

At least a second stent module (a second plurality of zig-zags 36 (forming an approximate turn) adjacent to the first) defining a second passageway; and

At least one polymer bridge in communication with the first and second stent module, said bridge coupling said first and second module. See at least figure 7 and column 3, lines 20 et seq. teaching a polymeric coating and types of polymers over most of the stent including internal and external surfaces.

The polymer bridges of Pinchuk do improve the flexibility when compared to welding them together as is well known in the art, this must be applicant's position also; see Cottone, Jr. (5,824,043). Finally, the Examiner notes that the materials taught by Pinchuk et al for the bridges are "flexible" materials and are the same materials taught by applicant; inherently, the materials must function the same.

Regarding at least claim 7 requiring a polymer hinge defining a gap, see column 2, lines 60-63, teaching the modules can touch or not touch (producing a gap).

Regarding the therapeutic agent, see column 4, lines 18 et seq. Regarding claim 13, "requiring at least "radio-opaque", it is the Examiner position that a radioactive material could be seen by "x-ray or other forms of radiant energy". See 4:28 of Pinchuk et al.

Regarding at least claim 15, "module is manufactured from a porous material" is interpreted as a product by process limitation wherein the final product (module) does not have to be porous.

Art Unit: 3738

Regarding claim 16, module is non-porous, the materials for the stent are non-porous.

Regarding claim 25, see at least column 7, lines 60 et seq.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce E. Snow whose telephone number is (571) 272-4759. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

bes



BRUCE SNOW
PRIMARY EXAMINER